

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Confirmation Number: 2091

George C. Carver, et al.

Group Art Unit: 3663

Serial No.: 10/795,879

Examiner: Mondt, Johannes P

Filed: March 8, 2004

Docket No.: 061404-1100

For: **Container and Method for Storing or Transporting Spent Nuclear Fuel**

REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is in reply to the Examiner's Answer, which was mailed October 27, 2010.

Reply to Examiner's Answer

Appellants continue to disagree with the Examiner's positions as to all claim rejections under appeal. Appellant's Appeal Brief sets forth, from a substantive basis, the reasons why the cited art does not properly teach the features that are being claimed. The rejections set forth in the Examiner's Answer repeat the prior positions taken by the Examiner in the FINAL Office Action. After that, beginning on page 28, the Examiner's Answer sets forth additional responsive comments to the arguments set forth in Appellant's appeal brief. This discussion, however, does not change the basis of the rejections set forth earlier in the Answer. Therefore, rather than restate or reiterate all of the bases and reasons why Appellants continue to disagree with the Examiner, Appellants re-allege herein the positions set forth in the Appeal Brief.

With regard to the Examiner's "Response to Argument" beginning on page 28, Appellant submits the following remarks. On page 28, the Examiner states the following:

"Appellant's first argument (pages 6-8) asserts that the Machado reference do not show that the four sidewalls form a continuous inner sidewall.

Examiner disagrees: according to the claim language the container *comprises* a plurality of tubes, each tube having four sidewalls the four sidewalls forming a continuous inner sidewall. Underscore added by examiner for emphasis. See claim 1, lines 1-5. Therefore, not all tubes necessarily need to meet the limitation on continuity of sidewalls, but instead it suffices when a sub-set does. The limitation on continuity of the four sidewalls is met for all C tubes. A fortiori (*sic*), there can be no teaching away by Machado in light of Machado's very teaching of said continuity of the four sidewalls."

To summarize the Examiner's statement, in response to Appellant's assertion that the Machado reference fails to show tubes with a continuous inner sidewall, the Examiner responds by arguing about the **number** of tubes in the prior art allegedly that meet the claimed limitation. It appears the Examiner is creating an argument about an issue that Appellant never raised. Appellant respond to this argument set forth by the Examiner by stating that it did not, in its Appeal Brief, argue about the **number** of tubes shown in the prior art. Instead, as stated in Appellant's Appeal Brief, Appellant argued that the prior art fails to disclose a continuous inner sidewall as recited in the instant claims. The Examiner fails to address the Appellant's assertions on this point.

On page 29, the Examiner states the following:

"Appellant's second argument (pages 8-9) asserts that the Machado reference does not teach the (or any) recesses (claim 1, line 9).

Examiner disagrees: following the contour of the sidewall in Figure 5 of Machado et al advanced by appellant in his argument and as cited by the Office action, there is an indentation or recess defined by the portion without the portions of element 54. Nothing in the specification justifies a

narrowing of the limitation "recess", of a sidewall, as an indentation following the contour of a sidewall."

In response, Appellant reiterates its extensive remarks, together with drawings reproduced from the instant application and the prior art, from pages 8-9 of Appellant's Appeal Brief, which are not specifically addressed by the Examiner aside from the two sentences quoted above.

The Examiner states the following on page 29:

Appellant's third argument (pages 9-10) states that Minshall et al fail to disclose a tube structure wherein it is possible to have a continuous inner sidewall and teach away from the limitation on the continuity of the sidewalls.

Examiner disagrees with the validity of this argument because (a) Minshall et al was not even cited for the limitation on the continuity of sidewalls, but instead only to supplement Machado et al for those limitations for which Machado et al is inadequate while even arguendo, (b) Minshall et al, far from "teaching away", actually teach continuity of sidewalls because plates such as 5d and 6e not only abut but even merge completely: see Figure 5 in Minshall et al.

In response, Appellant respectfully submits that the Examiner misrepresents Appellant's arguments. On page 10 of Appellant's Appeal Brief, Appellant states (statements which are not refuted by the Examiner) that the final Office Action admits that Machado fails to disclose "at least one corner of a first one of the tubes engaging another corner of a second one of the tubes," "each engaging a corner of the first and second ones of the tubes being formed from an intersection of a first sidewall and a second sidewall." Appellant then states that the final Office Action alleges beginning on page 9 of the Office Action that Minshall discloses these claim elements. Appellant, in its Appeal Brief, states various reasons why Minshall is deficient in this regard.

On page 30, the Examiner states the following:

Appellant's fifth argument (page 11) states that "the combination of the Machado reference with Minshall is improper, as the wall plates employed by Minshall would be incompatible with the L-shaped sections in the Machado reference".

Examiner disagrees: the wall plates by Minshall et al form just as much L-shaped section as the L-shaped section of Machado, as witnessed, for instance, by Figures 4-7.

Appellant respectfully disagrees as explained in its Appeal Brief, and notes that the Examiner, as evidenced above, remains *unable* to cogently explain how the Machado and Minshall references are compatible in this regard.

On page 30, the Examiner also states the following:

Appellant's sixth argument (pages 11-12) alleges that Declarations were ignored.

Examiner disagrees: all three Declarations all been adequately responded to. The first, second and third Declarations contain no showing of evidence of either criticality or non-obviousness, whether for the rejections of most recent record at the time (Loftis and Hoover) or for the rejections as appealed, which are different. They do not even address specific claim language. Counter to appellant's allegation of failure to review said declarations is not true: see discussion of the Declarations under "Response to Amendment" of the Office actions following directly the filing of said Declarations. They contain no evidence of superiority of the invention over the prior art, *a fortiori* (*sic*) not evidence of superiority of the invention over the prior art pertinent to the appeal.

Appellant submits that the Examiner, in the final Office Action on page 10, alleged that Appellants disclosed "no specific other advantage or improvement of the invention as disclosed is indicated in the specification." In response to these allegations, Appellant referenced numerous declarations submitted during the course of prosecution, which stated numerous advantages of an embodiment of the disclosure. See Exhibits A-C of Appellant's Appeal Brief. These Declarations are in direct

contradiction to the Examiner's statements. The above-referenced declarations contain various reasons that a design according to the pending claims are advantageous over the prior art, but the Examiner remains steadfast in ignoring their contents.

On page 30, the Examiner states the following:

"Regarding appellant's argument on claim 5, examiner refers to claim 4 on which claim 5 depends, for an extensive discussion complete with references, whereby it is unnecessary to provide more information."

Appellant respectfully disagrees. As quoted by MPEP 706.02(j), this Board has previously held that "to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or ***the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.***" *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (*Emphasis added*). With regard to claim 5, the Examiner has cited no references with regard to claim 5 and has presented **no** line of reasoning as to why the claimed invention would have been obvious in light of the teachings of the references.

With regard to claim 5, the Examiner alleges the following in the Examiner's Answer, quote in its entirety:

"On claim 5: the container further comprises a first and second set of the tubes, wherein the second rods are mounted on the tubes of the first set, wherein each of the second rods of the first set of tubes engages a respective one of the tubes in the second set of tubes."

As noted above, the Examiner presents no line of reasoning on which to base the rejection of claim 5. There are no citations to any other rejection of any other claim.

There are no citations to any prior art references. There are no citations to any subject matter whatsoever that forms a basis for rejecting this claim. Appellant finds it difficult to guess as to his line of reasoning supporting the rejection of claim 5.

MPEP 706.02(j) also instructs Examiners that "where a reference is relied on to support a rejection, whether or not in a minor capacity, **that reference should be positively included in the statement of the rejection.**" See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970). The rejection of claim 5 is in direct contravention of the MPEP in this regard, as there is no prior art reference cited in the rejection of claim 5. Accordingly, Appellant submits that the rejection of claim 5 is not only unfounded, but it also does not even comply with the guidelines set forth by the MPEP.

On page 31, the Examiner states:

"Appellant's argument on claim 7 alleges that reference numeral 34 does not include a plurality of load bearing surfaces at the corners, but refers to L-shaped sections.

Examiner disagrees: element 34 does include a plurality of load bearing surfaces at the corners (see also Figure 6 and col. 4, 1. 33-65)."

For convenience of the Board, column 4, lines 33-65 of Machado are reproduced below in their entirety:

"FIGS. 4-6 illustrate how the L-shaped sections are welded together to form cells. Variations in the characteristics of the stainless steel material after being exposed to varying temperatures and stresses during the manufacturing process, produces slight distortion in the material such that the L section longitudinal edges do not always fall in a vertical plane. Usually the longitudinal edges can be welded along their complete length as shown in FIGS. 5 and 6 wherein weld 42 metallurgically joins adjacent L-shaped sections 34. In the event the adjacent L sections of adjacent cells to be joined are spaced a distance greater than that which can be bridged by a single weld, such as weld 63, 0.81 inch spacer wire 68 shown in FIG. 5, is welded in the gap formed at the intersection of the L sections of adjacent cells. Separate welds 63 are then made between each section

and the wire spacer and along their complete height to provide stability to the fuel rack module. Since the space between adjacent sections may vary, it is evident that spacer wire, or other appropriate filler material, of different diameters or strips of different thicknesses and lengths may be welded to the adjacent L sections to hold the parts together.

The base plate 14 illustrated in FIGS. 3, 7 and 10 includes openings 30 which receive the bottom nozzle 64 (FIG. 10.) of a fuel assembly adapted to be placed in the opening 30 provided in each cell 16. As shown in FIG. 10, the plate opening 30 is of a size larger than the bottom nozzle 64 but smaller than an upper portion 66 thereof. The wall of opening 30 includes a bevel 64 complementary to the sides of the nozzle 64 which provides a surface area which supports a fuel assembly when positioned on the rack."

As stated in Appellant Appeal Brief, the cited portion of Machado fails to disclose the elements of claim 7. The cited portion of the reference discloses L-shaped sections and discusses how these sections are welded together, but the reference fails to disclose a plurality of load bearing surfaces at the corners as recited in claim 7. The reference fails to include any discussion of the load bearing nature of the L-shaped sections cited by the Examiner.

In response to the Examiner's statements on page 32, Appellant submits that it is well aware that the Examiner has removed Appellant's ability to seek the Board's review of his objections to the drawings by changing the basis of his rejections under 35 USC 112. The Examiner's statements on page 32 of the Examiner's Answer reflect a misunderstanding of the Appellant's statements in this regard, and the Appellant's position on these drawings objections are addressed on page 15 of Appellant's Appeal Brief.

Accordingly, for the reasons set forth during prosecution of the instant application, in Appellant's Appeal Brief, and above, Appellant respectfully submits that

the pending claims patently define over the cited art and that the claims should be allowed and the appealed rejection overturned.

CONCLUSION

For the reasons set forth above, Appellant submits that the pending claims are allowable and that the rejection of these claims should be overturned. No fees are believed to be due in connection with this submission. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 20-0778.

Respectfully submitted,

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